

### **REMARKS**

Reconsideration and withdrawal of the rejections set forth in the Office action dated April 9, 2003 are respectfully requested. Applicants petition the Commissioner for a 3-month extension of time. A separate petition accompanies this amendment.

#### **I. Amendments**

The specification is amended in accordance with 37 C.F.R. §1.821(d) to reference sequences in the application by use of the sequence identifier.

The Sequence Listing is amended in accordance with 37 C.F.R. §1.821 through 1.825 to depict all disclosed nucleotide and/or amino acid sequences in the Sequence Listing.

Claims 19-22 stand cancelled.

Claim 18 is amended to recite a Gt1 seed specific promoter and a Reb transcription factor as recited in original claim 21. Claim 18 is further amended to recite an increase in the expression of a gene under the control of the Gt1 seed-specific promoter. Support for this amendment is found on page 20, lines 10-15 and page 31, lines 20-25. Claim 18 is further amended for clarity.

New claims 23-24 find support on page 40, Table 3.

No new subject matter has been added by way of these amendments.

#### **II. Objections to the Specification**

The Examiner objected to the specification for allegedly not complying with the requirements for patent applications containing nucleotide and/or amino acid sequence disclosures for not incorporating SEQ ID NO's when referring to nucleic acid or amino acid sequences.

Applicants have amended the specification to make reference to sequences by the use of the sequence identifier in compliance with 37 C.F.R. §1.821(d).

### III Rejection under 35 U.S.C. §112, first paragraph

Claims 18-22 were rejected under 35 U.S.C. §112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 18-22 were further rejected under 35 U.S.C. §112, first paragraph, allegedly because the specification does not enable any person skilled in the art to which it pertains, or with which it is most connected to make and use the invention commensurate in scope with the claims.

These rejections are respectfully traversed.

#### A. Written Description

Specifically, the Examiner asserts that the specification fails to provide an adequate written description of the genus as broadly claimed. The claims, as amended, are directed to a method of making a modified Gt1 seed-specific promoter responsive to a Reb transcription factor.

The specification teaches preparing a heterologous construct containing the native Gt1 promoter modified to contain a 98 bp Reb UAS fragment (Gt1+UAS-GUS) (page 31, lines 13-19). The heterologous construct was tested by co-bombardment of developing endosperm with the native Reb gene, obtaining a 2.5 fold increase in GUS activity (page 31, lines 24-25 and Fig. 8B).

Accordingly, Applicants submit that these teachings in the specification show that Applicants had possession of the invention as presently claimed at the time of filing.

#### B. Enablement

The first paragraph of 35 U.S.C. §112 requires that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention without undue experimentation (e.g., *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir., 1991).

The enablement requirement is met if the description enables any mode of making and using the claimed invention (*Engel Industries, Inc. v. Lockformer Co.*, 946 F.2d 1528, 20 USPQ2d 1300 (Fed. Cir. 1991)).

As noted above, the amended claims are directed to claims a method of making a modified Gt1 seed-specific promoter responsive to a Reb transcription factor. Example 2 of the present invention provides guidance for an exemplary method of preparation and testing of a modified Gt1 seed-specific promoter responsive to a Reb transcription factor (page 30, line 34 through page 31, line 36). Guidance for identification of the upstream activation sequence for Reb is given on page 31, lines 3-12.

Accordingly, Applicants submit that the specification would enable any person skilled in the art to which it pertains to make and use the claimed invention.

In light of the teaching in the specification and Applicant's amendments, Applicants submit that the present claims satisfy the requirements of §112, first paragraph and respectfully request that the rejections be withdrawn.

#### IV. Rejection under 35 U.S.C. § 112, second paragraph

Claims 18-22 were rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 19-22 stand cancelled. The remaining rejections are set forth and addressed below.

1. The Examiner objected to the language "it" as allegedly not clear to what object the language refers. Applicants have amended claim 18 to clarify that the language refers to a native Gt1 seed-specific promoter.

2. The Examiner objected to the language "native state" as allegedly the metes and bounds have not been defined. Applicants have amended the claim language to clarify a native Gt1 seed-specific promoter. It is well known to one of skill in the art the metes and bounds of the term "native." The term is further defined on page 12, lines 2-4.

3. The Examiner objected to the language "increase" as allegedly lacking a comparative basis. Applicants have amended the claim for clarity. Applicants further direct the Examiner to page 31, lines 13-25 for an exemplary method of determining an increase in the expression of a gene under the control of the Gt1 seed-specific promoter as recited in amended claim 18.

4. The Examiner objected to the language "an increase in the activity of said seed specific promoter" as allegedly confusing. Specifically, the language "activity" is used in conjunction with proteins and is not used in conjunction with promoters. Applicants have amended the claim to clarify that the language refers to an increase in the expression of a gene under the control of the Gt1 seed-specific promoter.

In view of the above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

V. Rejections under 35 U.S.C. §102

Claims 19 and 20 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Nakase *et al.* (*Plant Molecular Biology*, 33:513-522, 1997).

Claims 19 and 20 stand cancelled.

VI. Rejections under 35 U.S.C. §103

Claims 19-20, and 22 were rejected under 35 U.S.C. §103 as allegedly obvious over Nakase *et al.* further in view of Jung *et al.* (U.S. Patent No. 5,850,016).

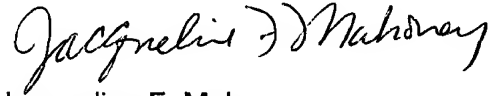
Claims 19-20, and 22 stand cancelled.

VII. Conclusion

In view of the foregoing, Applicants submit that the claims pending in the application are in condition for allowance. A Notice of Allowance is therefore respectfully requested.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4410.

Respectfully submitted,



Jacqueline F. Mahoney  
Registration No. 48,390

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**Correspondence Address:**

Customer No. 22918

Phone: (650) 838-4300